

Applicant: Dee et al.  
Application No.: 10/786,209

## Remarks

Claims 1 to 17, 19, 20, 22, 23 to 25, 27, and 28 are pending in this application. Claims 24, 25, 27 and 28 were not listed on the action Summary sheet, but were specifically addressed in the Detailed Action.

Independent claims 1, 4, 11, 17, and 24 have each been amended in essentially the same fashion. The composition in each of these claims is now recited to be “consisting essentially of” the components listed in the respective claims. All of the remaining claims depend from one of these amended independent claims, so all of the claims of this application are now “consisting essentially of” claims.

Claims 1 to 13, 15 to 17, 19, 20, 22 to 25, and 28 were rejected under 35 U.S.C. §102(b) as anticipated by *Kabara* or in the alternative as obvious over *Kabara*. The reasons for these rejections are apparently the same as those provided in earlier actions.

Claims 1 to 14, 16, 17, 19, 20, 22 to 25, 27 and 28 were rejected under 35 U.S.C. §102(b) as anticipated by *Andrews* or in the alternative under 35 U.S.C. §103(a) as obvious over *Andrews*. The reasons for the rejections under *Andrews* are apparently provided as being similar to the rejections based on *Kabara*.

## *Kabara*

The disclosure of *Kabara* was considered by the U.S. Patent & Trademark Office Board of Patent Appeals and Interferences (“the Board”) in an earlier appeal of Application No. 08/602,498 (now U.S. Patent 6,699,907), which is a parent to the present application. The Board considered two types of claims in the appeal. The first was a “consisting essentially of” claim, and the second was a “comprising” claim. Both claims included essentially the same composition

ingredients. The claims of the present application have been amended to be “consisting essentially of” claims, and the Board’s decision regarding that type of claim is discussed herein.

In its ruling, the Board agreed with Appellants’ argument that “one interested in the art of teat dips, would look to Kabara’s exemplified teat dips (examples 2-4) that contain significantly less propylene glycol than required for the compositions of the claimed methods.” (Ex. A, p. 8.) Thus, the Board has already ruled that *Kabara* does not disclose a teat dip with a propylene glycol concentration as was recited in claim 14 of the parent case being “from about 60% to about 95% of lipophilic polar solvent...” (Ex. A, p. 1, claim 14.)

Like claim 14 from the parent application, the above amended claims are now allowable over *Kabara*. The claims of this case have a solvent concentration range that distinguishes *Kabara* for the same reasons the Board used in ruling that claim 14 was allowable. Further, amended claims 1 and 4 of this application are similar to appealed and allowed claim 14 except that claims 1 and 4 recite the additional ingredient of a “secondary solvent.” The secondary solvent of water was present in the compositions that were compared on appeal and had no bearing on the holding that claim 14 was patentable over *Kabara*.

Amended claims 11, 17, and 24 are similar to appealed and allowed claim 14 except that the lipophilic polar solvent is specified by a dielectric constant of greater than 25. This range covers both compositions being compared on the appeal of claim 14. In addition, amended claim 24 is directed to a composition as opposed to the method in appealed claim 14, but the method recited the use of a composition similar to claim 24 except for the dielectric constant discussed above.

The Board’s conclusion was reached in regard to an anticipation rejection. Nonetheless, the absence of a teaching of the claimed range of polar solvent concentration is relevant to

Applicant: Dee et al.  
Application No.: 10/786,209

whether the same claim would have been obvious, and the Board concluded claim 14 was not obvious as well.

In further support for the non-obviousness of the amended claims, Applicants submit herewith the Meister Declaration (Ex. B) that was relied on by the Board in the previous appeal to show that *Kabara*, even when modified to include a 60% propylene glycol concentration is unstable at low temperatures.

The Board concluded:

It is well settled that “[t]he word ‘essentially’ [in ‘consisting essentially of’] opens the claims to the inclusion of ingredients which would not materially affect the basic and novel characteristics of appellant’s compositions as defined in the balance of the claim.” In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963) (emphasis in original). In our opinion, the Meisters Declaration demonstrates that Kabara includes ingredients that affect the basic and novel characteristics of appellants’ composition, and thereby would affect the claimed method of using the composition. Therefore, we cannot agree with the examiner’s position (Answer, page 5), “there is no preclusion of the fatty ester, as appellant [sic] claims.”

Therefore, the amended claims exclude a fatty acid ester because claims 1 and 4 include only a solvent, two fatty acids, and a secondary solvent such as water, alcohol or mixtures thereof. Support for these claims is found at p. 7, paragraph 27 and paragraph 29 (examples 1 and 2), for example. Claims 11 and 17 recite methods of using compositions and claim 24 recites a composition that defines a solvent by its dielectric constant as discussed above. Thus, the conclusion of allowability reached by the Board for claim 14 applies to the amended claims in the present application, as well.

Applicants further note that their previous assertion that the disclosure and scope of dielectric constants in the present application adequately supports the claim was not countered in the latest office action. Therefore, Applicants respectfully assume that the examiner agrees that 35 U.S.C. §112 has been satisfied.

Applicant: Dee et al.  
Application No.: 10/786,209

***Andrews***

*Andrews* was filed on February 7, 1995 and issued on October 29, 1996. The parent application of the present application has a priority date of February 20, 1996, which is before *Andrews*' issue date. Thus, the §102(b) rejection appears to be incorrect. Even if the rejection had been made under 35 U.S.C. §102(e), *Andrews* is not prior art because §102(e) requires that a reference be disclosed in a patent that issued from an application filed before the *invention* of the present application. As was determined by the Board in the previous appeal (Ex. A, pp. 2 to 7), the present invention was developed as early as December 6-7, 1994 and was provided to a veterinarian for field testing on January 31, 1995, which is before *Andrews*' filing date (Ex. A, p. 5.) Thus, *Andrews* is not prior art even under 35 U.S.C. §102(e) because it was disclosed in an application filed after the invention of the present application.

Applicants submit herewith in Ex. C, the declarations of Alejandro Dee and Dr. Michael Gardner from the above-referenced appeal as evidence of the date of invention.

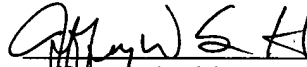
In any event, *Andrews* fails to disclose the present invention because there is no disclosure of a teat dip consisting essentially of fatty acids, a polar solvent, and (as in claims 1 and 4) a secondary solvent.

Applicant: Dee et al.  
Application No.: 10/786,209

**Conclusion**

For the foregoing reasons, Applicants respectfully submit that the amended claims and their respective dependent claims are in condition for allowance and that this case be passed to issue.

Respectfully submitted,

  
\_\_\_\_\_  
Jeffrey W. Smith, Reg. No. 33455  
Attorney for Applicant  
SMITH LAW OFFICE  
440 Science Drive, Suite 302  
Madison, WI 53711  
(608) 663-8200